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ALEXANDRIA, VA 22320			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

."	Application No.	Applicant(s)	
	10/658,778	HAYASHI ET AL.	
Office Action Summary	Examiner	Art Unit	_
	William C. Storey	2609	
The MAILING DATE of this communication a Period for Reply	ppears on the cover sheet w	th the correspondence address	
A SHORTENED STATUTORY PERIOD FOR REP WHICHEVER IS LONGER, FROM THE MAILING - Extensions of time may be available under the provisions of 37 CFR 1 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory perio - Failure to reply within the set or extended period for reply will, by statuenty and the set of the set of the set of the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statuenty reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNION (I.136(a). In no event, however, may a red will apply and will expire SIX (6) MONute, cause the application to become AE	CATION. eply be timely filed THS from the mailing date of this communication. EANDONED (35 U.S.C. § 133).	•
Status			
1) Responsive to communication(s) filed on 10	September 2003.		
2a) This action is FINAL . 2b) ⊠ Th	is action is non-final.		
3) Since this application is in condition for allow	•		
closed in accordance with the practice under	Ex parte Quayle, 1935 C.D	. 11, 453 O.G. 213.	
Disposition of Claims			
4) ☐ Claim(s) 1-12 is/are pending in the application 4a) Of the above claim(s) is/are withdrest is/are allowed. 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 1-12 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and are subject.	awn from consideration.		
Application Papers			
9) ☐ The specification is objected to by the Examir 10) ☑ The drawing(s) filed on 10 September 2003 is Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) ☐ The oath or declaration is objected to by the Examination is objected to by the Examination is objected.	s/are: a)⊠ accepted or b)□ e drawing(s) be held in abeyar ection is required if the drawing	ce. See 37 CFR 1.85(a). (s) is objected to. See 37 CFR 1.121(d).	
Priority under 35 U.S.C. § 119			
a) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1 Certified copies of the priority documer 2 Certified copies of the priority documer 3. Copies of the certified copies of the priority application from the International Bureat * See the attached detailed Office action for a list	nts have been received. nts have been received in A ority documents have been au (PCT Rule 17.2(a)).	pplication No received in this National Stage	
Attachment(s) I) ⊠ Notice of References Cited (PTO-892)	4) 🔲 Interview S	ummary (PTO-413)	
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	Paper No(s)/Mail Date formal Patent Application	

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 1. Claim 1, 2, 5, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Eguchi (US Patent 6982803).

Regarding claim 1, Eguchi discloses an email receiving part that receives an email; a facsimile-forwarding part that facsimile-forwards the email received by the email receiving part; a forwarding-size-upper-limit setting part that sets a predetermined forwarding size upper limit; and a facsimile-forward limiting par that limits the facsimile-forwarding when the forwarding size to be facsimile-forwarded by the facsimile-forwarding part exceeds the forwarding size upper limit set by the forwarding-upper-limit-size setting part. In addition, Eguchi discloses a facsimile server, electronic mail device, and communication method. Further, Eguchi discloses a facsimile server 2, which reads on claimed email receiving part; which extracts electronic mail, which reads on claimed receives an email; as disclosed at Figure 2 and column 5, lines 43-44. Eguchi discloses that the facsimile server 2, which reads on claimed facsimile-forwards the electronic mail, which reads on claimed facsimile-forwards the email received by the email receiving part; as disclosed at Figure 2 and column 5, line 45. Eguchi discloses a RAM 21, which reads on claimed forwarding-size-upper-

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limit setting part; which the capacity of is a designated value, which reads on claimed predetermined forwarding size upper limit; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4. Eguchi discloses the when the data size, which reads on claimed forwarding size; is larger than the designated value, which reads on exceeds the forwarding size upper limit; the facsimile server 2, which reads on claimed facsimile-forward limiting part; does not receive the electronic mail from the electronic mail box, hence preventing fax transmission, which reads on claimed limits the fax forwarding; as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.

Regarding claim 2, Eguchi discloses everything as applied above for claim 1. Claim 2 is rejected upon the same reasoning as applied for claim 1. Specifically, Eguchi discloses the when the data size, which reads on claimed forwarding size; is larger than the designated value, which reads on exceeds the forwarding size upper limit; the facsimile server 2, which reads on claimed facsimile-forward limiting part; does not receive the electronic mail from the electronic mail box, hence preventing fax transmission, which reads on claimed prohibits the facsimile-forwarding; as opposed to when the data size is smaller and the electronic mail is received as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.

Regarding claim 5, Eguchi discloses everything as applied above for claim 1.

Claim 5 is rejected upon the same reasoning as claim 1. Specifically, Eguchi discloses

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a RAM 21, which reads on claimed forwarding-size-upper-limit setting part; which the capacity of is a designated value, which reads on claimed forwarding size upper limit; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4. In addition, Eguchi discloses a check of the data size of the electronic mail, which reads on claimed data size of the data to be facsimile-forwarded by the facsimile-forwarding part, as disclosed at column 5, lines 4-7.

Regarding claim 12, claim 12 is rejected upon the same reasoning as applied above for claim 1. Further, Eguchi discloses a facsimile server 2, which reads on claimed image communication apparatus including facsimile sending part; as disclosed at Figure 2 and column 5, lines 43-44. Eguchi discloses that the facsimile server 2, which reads on claimed facsimile-forwarding part; forwards the electronic mail, which reads on claimed facsimile-forwards the email received by the email receiving part; as disclosed at Figure 2 and column 5, line 45. Eguchi discloses a RAM 21, which reads on claimed sending-size-upper-limit setting part; which the capacity of is a designated value, which reads on claimed sending size upper limit; as disclosed at Figure 2 and column 4, line 15, and column 5, line 2-4. Eguchi discloses the when the data size, which reads on claimed size to be sent; is larger than the designated value, which reads on exceeds the sending size upper limit; the facsimile server 2, which reads on claimed facsimile sending limiting part; does not receive the electronic mail from the electronic mail box, hence preventing fax transmission, which reads on claimed limits facsimile sending; as opposed to when the data size is smaller and the electronic mail is received

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as usual, thereby allowing fax transmission, as disclosed at Figure 2 and column 5, lines 4-7, lines 11-16, 22-37.

Claim Rejections - 35 USC § 103

- 2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eguchi in view of Najafi (US Patent 5442457).

Regarding claim 3, Eguchi discloses everything as applied above for claim 1. In addition, Eguchi discloses dividing the original electronic mail, which reads on claimed splits data to be facsimile-forwarded into a plurality of units, as disclosed at column 5, line 53. However, Eguchi fails to distinctly point out the sending the split units separately. However, the examiner maintains that it was well known in the art to provide sending the split units separately, as taught by Najafi.

In a similar field of endeavor, Najafi discloses a multi-line pooling facsimile apparatus. In addition, Najafi discloses a CPU 13 that divides the fax data into shares or portions and sends the data using separate lines from one fax machine to a similar fax machine that may reassemble the data at the other end, which reads on claimed facsimile-forward limiting part splits the data to be facsimile-forwarded into a pluarality of units and facsimile-forwards the units separately, as disclosed in Figure 2 and column 3, lines 27-33.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eguchi by specifically providing sending split units separately, as taught by Najafi, for the purpose of conforming with the division idea proposed by Eguchi, as disclosed at column 5, line 53.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eguchi in view of Yukie et al. (US Patent 6956833), hereinafter referred to as Yukie.

Regarding claim 4, Eguchi discloses everything as applied above for claim 1. However, Eguchi fails to disclose sending the fax at a preset time. However, the examiner maintains that it was well known in the art to provide sending the fax at a preset time, as taught by Yukie.

In a similar field of endeavor, Yukie discloses a method, system and devices for wireless data storage on a server and data retrieval. In addition, Yukie discloses user device 10, which may be actualized as a number of devices including a camera or a fax machine, as disclosed at column 6, lines 55-56, column 10, lines 41-43, and Figure 1. Eguchi discloses the user device sending an image at an automatically preset time, which reads on sending a fax at a preset time, as disclosed at column 6, lines 63-65.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eguchi by specifically providing sending the fax at a preset time, as taught by Yukie, for the purpose of getting work done ahead of time and not having to wait until the appropriate reception time.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eguchi in view of Okutomi et al. (US Patent 6211972), hereinafter referred to as Okutomi.

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Regarding claim 6, Eguchi discloses everything as applied above for claim 1.

However, Eguchi fails to disclose limiting by page size. However, the examiner maintains that it was well known in the art to provide limiting by page size, as taught by Okutomi.

In a similar field of endeavor, Okutomi discloses an electronic mail converting apparatus for facsimile. In addition, Okutomi discloses a LAN controlling section that compares the number of fax sheets to be produced from an email with the maximum number of sheets the fax machine has to output, as disclosed at column 6, lines 48-51 and 61-66. The maximum number of sheets the fax machine has to output reads on upper size limit determined by page size of the data to be faxed. If the maximum number of sheets the fax machine has to output is less than the number of email pages, then the transmission is limited, as disclosed in column 6, lines 66-67 and column 7, lines 1-4 and 14-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eguchi by specifically providing limiting by page size, as taught by Okutomi, for the purpose of saving cost, as disclosed in column 7, lines 21-23.

6. Claim 7, 8, 9, 10, & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eguchi in view of Kaufeld et al. (US Patent 5859967), hereinafter referred to as Kaufeld.

Regarding claim 7, Eguchi discloses an email receiving part that receives an email and a facsimile-forwarding part that facsimile-forwards the email received by the

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email receiving part. Further, Eguchi discloses a facsimile server 2, which reads on claimed email receiving part; which extracts electronic mail, which reads on claimed receives an email; as disclosed at Figure 2 and column 5, lines 43-44. Eguchi discloses that the facsimile server 2, which reads on claimed facsimile-forwarding part; forwards the electronic mail, which reads on claimed facsimile-forwards the email received by the email receiving part; as disclosed at Figure 2 and column 5, line 45. However, Eguchi fails to disclose a registering part that registers email addresses of predetermined senders of the email; and limiting the forwarding when the email address of a sender of the email to be forwarded is not registered in the registering part. However, the examiner maintains that it was well known in the art to provide a registering part that registers email addresses of predetermined senders of the email; and limiting the forwarding when the email addresses of a sender of the email to be forwarded is not registered in the registering part, as taught by Kaufeld.

In a similar field of endeavor, Kaufeld discloses a method and system for relaying communications from authorized users. In addition, Kaufeld discloses a means for registering to a database, which reads on claimed registering part; identification information including a personal email address, which reads on claimed email addresses of predetermined senders of the email; that is required to be used for transmission of a fax from email, as disclosed at column 4, lines 58-67 and column 5, lines 1-5. Kaufeld discloses checking for a valid account by comparing the email address of the sender with a database containing valid accounts. If the email address from which the message has been sent, which reads on claimed email address of a

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sender of the email; does not correspond to a valid account, which reads on claimed is not registered in the registering part; flow proceeds from step 174 to step176, which transmits a message back to the sender that a valid count does not exist and the process of Figure 8A ends, which reads on claimed limits the facsimile-forwarding; as opposed to a positive response at step 174, which leads to the continuation of the process of Figure 8A and eventual fax transmission (or forwarding), as disclosed in Figure 8A, column 7, lines 43-51 and 58-60.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eguchi by specifically providing a registering part that registers email addresses of predetermined senders of the email; and limiting the forwarding when the email address of a sender of the email to be forwarded is not registered in the registering part, as taught by Kaufeld, for the purpose of establishing a secure manner of billing users to forward a received electronic mail message by facsimile, as disclosed at column 1, lines 43-46.

Regarding claim 8, Eguchi and Kaufeld disclose everything as applied above for claim 7. Further, Kaufeld discloses checking for a valid account by comparing the email address of the sender with a database containing valid accounts. If the email address from which the message has been sent, which reads on claimed email address of a sender of the email; does not correspond to a valid account, which reads on claimed is not registered in the registering part; flow proceeds from step 174 to step 176, which transmits a message back to the sender that a valid count does not exist and the process of Figure 8A ends, which reads on claimed prohibits the facsimile-forwarding;

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as opposed to a positive response at step 174, which leads to the continuation of the process of Figure 8A and eventual fax transmission (or forwarding), as disclosed in Figure 8A, column 7, lines 43-51 and 58-60.

Regarding claim 9, Equchi discloses an email receiving part that receives an email and a facsimile-forwarding part that facsimile-forwards the email received by the email receiving part. Further, Eguchi discloses a facsimile server 2, which reads on claimed email receiving part; which extracts electronic mail, which reads on claimed receives an email; as disclosed at Figure 2 and column 5, lines 43-44. Eguchi discloses that the facsimile server 2, which reads on claimed facsimile-forwarding part; forwards the electronic mail, which reads on claimed facsimile-forwards the email received by the email receiving part; as disclosed at Figure 2 and column 5, line 45. However, Eguchi and Kaufeld did not disclose a determining part that determines whether the facsimileforwarding by the facsimile-forwarding part is instructed by the email or by setting of the image communication apparatus; and a control part that discards the email if the determining part determines that the facsimile-forwarding is instructed by the email, and saves the email if the determining part determines that the facsimile-forwarding is instructed by setting of the image communication apparatus, when the facsimileforwarding by the facsimile-forwarding part fails. However, the examiner maintains that it was well known in the art to provide a determining part that determines whether the facsimile-forwarding by the facsimile-forwarding part is instructed by the email or by setting of the image communication apparatus; and a control part that discards the email if the determining part determines that the facsimile-forwarding is instructed by the

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email, and saves the email if the determining part determines that the facsimileforwarding is instructed by setting of the image communication apparatus, when the facsimile-forwarding by the facsimile-forwarding part fails, as taught by Kaufeld.

In a similar field of endeavor, Kaufeld discloses a method and system for relaying communications from authorized users. Kaufeld discloses a "To:" line of an email for fax-forwarding that contains the phone number of the receiving fax in an email address. which reads on claimed facsimile-forwarding by the facsimile-forwarding part is instructed by the email, as disclosed in Figure 4 and column 6, lines 45-48. Kaufeld discloses a transmission computer 26, which reads on claimed determining part, as disclosed at column 3, lines 31-42. Image communication apparatus is read on by all the components of which it is comprised. Kaufeld discloses checking for a valid account by comparing the email address of the sender with a database containing valid accounts, which reads on claimed setting of the image communication apparatus. If the email address from which the message has been sent does not correspond to a valid account flow proceeds from step 174 to step 176, which transmits a message back to the sender that a valid count does not exist and the process of Figure 8A ends, which reads on claimed discards the email if the determining part determines that the facsimile-forwarding is instructed by the email, as opposed to a positive response at step 174, which leads to the continuation of the process of Figure 8A and eventual fax transmission (or forwarding), as disclosed in Figure 8A, column 7, lines 43-51 and 58-60. It is well known in the art to use a "store-and-forward," method that will store a copy of the information to be transmitted until the transmission is completed when trying to

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perform a fax transmission, which reads on claimed saves the email if the determining part determines that the facsimile-forwarding is instructed by setting of the image communication apparatus, when the facsimile-forwarding by the facsimile-forwarding part fails.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eguchi by specifically providing a determining part that determines whether the facsimile-forwarding by the facsimile-forwarding part is instructed by the email or by setting of the image communication apparatus; and a control part that discards the email if the determining part determines that the facsimile-forwarding is instructed by the email, and saves the email if the determining part determines that the facsimile-forwarding is instructed by setting of the image communication apparatus, when the facsimile-forwarding by the facsimile-forwarding part fails, as taught by Kaufeld, for the purpose of conserving cost and increasing security, as disclosed at column 1, lines 43-46.

Regarding claim 10, Eguchi and Kaufeld disclose everything as applied above for claim 9. However, Eguchi and Kaufeld did not disclose a reporting part that sends a report of facsimile-forwarding failure to the sender of the email if the determining part determines that the facsimile-forwarding is instructed by the email, or sends a report of the facsimile-forwarding failure to the forwarding destination of the facsimile-forwarding if the determining part determines that the facsimile-forwarding is instructed by the setting of the apparatus, when the facsimile-forwarding by the facsimile-forwarding part fails. However, the examiner maintains that it was well known in the art to provide a

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reporting part that sends a report of facsimile-forwarding failure to the sender of the email if the determining part determines that the facsimile-forwarding is instructed by the email, or sends a report of the facsimile-forwarding failure to the forwarding destination of the facsimile-forwarding if the determining part determines that the facsimile-forwarding is instructed by the setting of the apparatus, when the facsimile-forwarding by the facsimile-forwarding part fails, as taught by Kaufeld.

In a similar field of endeavor, Kaufeld discloses a method and system for relaying communications from authorized users. In addition, Kaufeld discloses if the email address from which the message has been sent does not correspond to a valid account, flow proceeds from step 174 to step 176 which transmits a message back to the sender, which reads on claimed report of facsimile-forwarding failure to the sender of the email; that a valid count does not exist and the process of Figures 8A-8c ends, which reads on claimed facsimile-forwarding by the facsimile-forwarding part fails; as disclosed at column 7, lines 46-51 and Figure 8A.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eguchi by specifically providing a reporting part that sends a report of facsimile-forwarding failure to the sender of the email if the determining part determines that the facsimile-forwarding is instructed by the email, or sends a report of the facsimile-forwarding failure to the forwarding destination of the facsimile-forwarding if the determining part determines that the facsimile-forwarding is instructed by the setting of the apparatus, when the facsimile-forwarding by the

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facsimile-forwarding part fails, as taught by Kaufeld, for the purpose of conserving cost and increasing security, as disclosed at column 1, lines 43-46.

Regarding claim 11, Eguchi discloses an email receiving part that receives an email and a facsimile-forwarding part that facsimile-forwards the email received by the email receiving part. Further, Eguchi discloses a facsimile server 2, which reads on claimed email receiving part; which extracts electronic mail, which reads on claimed receives an email; as disclosed at Figure 2 and column 5, lines 43-44. Eguchi discloses that the facsimile server 2, which reads on claimed facsimile-forwarding part; forwards the electronic mail, which reads on claimed facsimile-forwards the email received by the email receiving part; as disclosed at Figure 2 and column 5, line 45. In addition, Eguchi dislcloses facsimile-forwarding based on an instruction of the facsimile-forwarding instructed by the email while ignoring an instruction of the facsimile-forwarding set within the image communication apparatus, and the instruction of the facsimileforwarding is set within the image communication apparatus. Further, Eguchi discloses the email containing a destination address for the forwarding-facsimile server, which reads on claimed facsimile-forwarding based on an instruction of the facsimileforwarding instructed by the email, as disclosed at column 3, lines 5-15. Eguchi discloses a transmitting control unit that manages the transmission of electronic mail and its passage for forwarding or not, which reads on claimed facsimile-forwarding control part, as disclosed at column 4, lines 29-35. Eguchi discloses the fax server, which reads on claimed facsimile-forwarding set within the image communication apparatus, checking to see whether or not the e-mail is exceeding a designated value

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(s3). When the email is not less than a value, the facsimile-forwarding set processes the e-mail receipt (s4), which reads on claimed the instruction of the facsimile-forwarding is set within the image communication apparatus; and ignores instructions s5-s13, which reads on claimed ignoring an instruction of the facsimile-forwarding set within the image communication apparatus; as disclosed in Figure 3. However, Eguchi did not disclose a determining part that determines whether the facsimile-forwarding by the facsimile-forwarding part is instructed by the email or not. However, the examiner maintains that it was well known in the art to provide a determining part that determines whether the facsimile-forwarding by the facsimile-forwarding part is instructed by the email or not, and the instruction of the facsimile-forwarding is set within the image communication apparatus, as taught by Kaufeld.

Kaufeld discloses a "To:" line of an email for fax-forwarding that contains the phone number of the receiving fax in an email address, which reads on claimed facsimile-forwarding by the facsimile-forwarding part is instructed by email, as disclosed in Figure 4 and column 6, lines 45-48. Kaufeld discloses a transmission computer 26, which reads on claimed determining part, as disclosed at column 3, lines 31-42. When the "To:" line of an email for fax-forwarding does not contain the phone number of a receiving fax in an email address, this situation would read on claimed "not," when the facsimile-forwarding is not instructed by email.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eguchi by specifically providing a determining part that determines whether the facsimile-forwarding by the facsimile-forwarding part is

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instructed by the email or not, as taught by Kaufeld, for the purpose of conserving cost and increasing security, as disclosed at column 1, lines 43-46.

Citation of Pertinent Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Publication 2002/0059389 discloses an electronic-mail apparatus. US Paten Publication 2003/0030848 discloses a facsimile device and control method. US Patent Publication 2002/0054335 discloses a communication apparatus and method having electronic mail communication function and program.

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Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Storey whose telephone number is 571-270-3576. The examiner can normally be reached on Monday - Friday (Alternate Fridays off) 7:30-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jefferey F. Harold can be reached on 571-272-7519. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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William C Storey

Examiner Art Unit 2609

WCS

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PAJA YANG PRIMARY EXAMINER